

## REMARKS

Claims 1 through 29 are in the application, with Claims 1, 13 and 24 being independent.

The pending claims are subject to a new restriction requirement. In particular, the Office Action again groups the claims into Claims 1 through 12 (Group I), Claims 13 through 23 (Group II), and Claims 24 through 29 (Group III). Election of one of these Groups is required because the Groups are alleged to be distinct.

In response to the restriction requirement, Applicants provisionally elect Group II, Claims 13 through 23. Examination and allowance of the elected claims are respectfully requested.

This provisional election is made with traverse. Applicants request reconsideration of the restriction requirement in light of the following arguments, and pursuant to 37 CFR §1.143. As grounds for traversal, Applicants believe that Groups I through III are clearly not distinct from one another.

### Alleged distinctiveness between Group I and Group II

Restriction is proper only where an application contains claims directed to two or more independent or distinct inventions. As described in the Office Action, claims directed to a product (i.e., the Group II claims) and to a process for making the product (i.e., the Group I claims) are distinct if the product as claimed can be made by another and materially different process. The Group I and Group II claims are alleged to be distinct because “the underfill could be applied to the second die instead of the first die.”

Applicants agree that an alleged process in which the underfill is applied to the second die instead of the first die is different from the claimed process. However, the alleged process cannot be deemed materially different, as required by the above-recited test. Such an interpretation of M.P.E.P. §806.05(f) would render the term “materially” meaningless.

### Alleged distinctiveness between Group I and Group III

The Office Action identifies the Group I and Group III claims as a process of making and product made, respectively. These Groups are alleged to be distinct for the same reason described above with respect to the Group I and Group II claims. In particular, the Office Action

alleges the Groups to be distinct because “the underfill could be applied to the second die instead of the first die.”

Again, Applicants submit that the alleged process cannot properly be deemed materially different from the claimed process. If the alleged process could be deemed materially different from the claimed process, then any difference would constitute a material difference.

Alleged distinctiveness between Group II and Group III

The Office Action also indicates that Group II and Group III represent a subcombination and a combination as described in MPEP §806.05(c)II. The Office Action further indicates that the groups are distinct because 1) the combination does not require the particulars of the subcombination for patentability and 2) the subcombination has utility by itself or in other combinations. In support of the first prong, the Office Action states “the combination as claimed does not require particulars of the subcombination as claimed because some claims include limitation (*sic*) to the specific underfill”.

The foregoing statement has no bearing on whether the combination requires particulars of the subcombination for patentability. Rather, the separately claimed subcombination of Group II “constitutes the essential distinguishing feature of the combination” of Group III. Restriction therefore “must not be made” (see §806.05(c)II) between Group II and Group III.

In summary, Group I is clearly not distinct from Group II or from Group III, and Group II is clearly not distinct from Group III. Restriction between these Groups is therefore believed to be improper.

The Office Action also requires election of one of six alleged patentably distinct species. As Group II was provisionally elected above, Applicants may elect one of Group II species a. or Group II species b. However, Applicants submit that the arrangements of Group II species a. and Group II species b. are not mutually exclusive and therefore do not represent different species. In other words, the arrangements may be used in a single embodiment. Some embodiments may employ only one or two of the illustrated arrangements. Applicants respectfully submit that the Office Action’s election requirement is in error and request withdrawal thereof.

Nevertheless, in order to provide a complete response to the Office Action, Applicants provisionally elect Group II species a., and submit that Claims 13 through 23 are readable thereon.

## C O N C L U S I O N

Applicants therefore respectfully request withdrawal of the outstanding restriction and election requirements and examination of Claims 1 through 29 on the merits. In this regard, Claims 1 through 29 are believed to be in condition for allowance and such action is respectfully requested at the Examiner's earliest convenience.

If there remains any question regarding the present application, or if the Examiner has any suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact the undersigned via telephone at (203) 972-0049.

Respectfully submitted,

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Date



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